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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,355	09/16/2003	Atsushi Miyawaki	0051-0212P	2060

2292 7590 12/28/2006  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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TRAN, PHUOC

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	12/28/2006	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/28/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/662,355	<b>Applicant(s)</b> MIYAWAKI ET AL.	
	<b>Examiner</b> Phuoc Tran	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 3-5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/9/04, 11/4/04, 5/24/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerstner et al [Patent No. 6,819,415].

As to claim 1, Gerstner et al disclose an microscope system comprising: a control means capable of generating electric control signals (Fig. 1, item 15; col. 3, lines 2-21); a spatial modulator means having an illuminated surface to be illuminated by light emitted by a light source, and capable of receiving the electric control signal and of spatially modulating reflection characteristic or transmission characteristic of the illuminated surface by a spatial frequency specified by the electric control signal (Fig. 3, items 3,4; col. 2, lines 16-61; col. 3, lines 12-25); an illuminating optical means for illuminating a specimen with light spatially modulated by the spatial modulator means (Fig. 3, items 5, 7, 11, 10; col. 2, lines 59-67); an image detecting means for detecting a signal image formed by signal light emitted by the specimen illuminated by the illuminating optical means (Fig. 3, item 14, col. 3, lines 9-11); and an arithmetic means for processing signal images formed by using the spatial frequency of at least three different phases set by the control means and detected by the image detecting means to obtain an optical sectioned image (Fig. 3, item 16, col. 11-26).

As to claim 2, Gerstner et al disclose that the control means is capable of setting a

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thickness for the optical sectioned image by setting the spatial frequency (col. 3, lines 2-25; col. 5, lines 1-16).

As to claim 8, Gerstner et al disclose that the spatial modulator means receives the electric control signal and is capable of sinusoidally spatially modulating the reflection characteristic or the transmission characteristic of the illuminated surface according to the electric control signal (col. 4, lines 53-57; col. 5, lines 15-20).

As to claim 9, Gerstner et al disclose that the signal light is reflected light, transmitted light or fluorescent light (col. 3, lines 3-12).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerstner et al [Patent No. 6,819,415] in view of Proll K-P et al cited by applicants.

Gerstner et al disclose all the claim limitations as mentioned above except for using a digital micromirror device or a liquid crystal device as the spatial modulator means. Proll K-P et al teach it is well known in the art to use a digital micromirror device or a liquid crystal device as the spatial modulator means (see Introduction and Experimental Setup sections). It would have been obvious to one of ordinary skill in the art to use a digital micromirror device or a liquid crystal device as the spatial modulator means in Gerstner et al's device for the purpose of improving of phase-shift measurement results.

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5. Claims 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Derndinger et al (6,429,897) and Wolleschensky et al (6,947,133) disclose an arrangement of a microscope.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc Tran whose telephone number is (571) 272-7399.

The examiner can normally be reached on MON-FRI.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew C. Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Phuoc Tran*  
**PHUOCTRAN**  
**PRIMARY EXAMINER**